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EXAMINER

HAVAN, THU THAO

ART UNIT

PAPER NUMBER

3693

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/799,254

**Applicant(s)**

SANCHEZ ET AL.

**Examiner**

THU-THAO HAVAN

**Art Unit**

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 1-46 are pending. This action is in response to the remarks received January 25, 2008.

### ***Response to Arguments***

The rejection of claims 1-46 under 35 U.S.C. 103(a) as being unpatentable by Keresman, III et al. (US 7,051,002) and Itakura (US 2005/0010488) is maintained.

Upon a closer examination, Applicant's arguments filed January 25, 2008 have been fully considered but they are not persuasive.

In response to the arguments concerning the previously rejected claims the following comments are made:

A.) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., processor located at a merchant site that determines a format of a credit card) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 3693

B.) Applicant alleges that the prior art made of record fails to teach by a processor located at a merchant site. The examiner disagrees with applicant's representative since Keresman teaches by a processor located at a merchant site (col. 7, lines 40 to col. 8, lines 38; col. 5, line 41 – col. 6, line 14; col. 5, line 25-33 and line 58-65; col. 10, line 47-63). Keresman enables merchants to connect and process a specific payment authentication transaction. He discloses authenticated payments, allowing a merchant to securely and easily accommodate authentication of consumers and/or cardholders in accordance with a variety of authentication initiatives implemented by credit card networks, and to process electronic transactions through any payment network using a single platform. It also enables merchants to process these payments, regardless of which payment network they are to be routed through, with a single implementation. For example, the merchant sends an authorization/sale transaction to their payment gateway along with the data elements received from the PAREs. The payment gateway routes the data to the acquiring bank based on the acquirer's specification. The acquiring bank then sends the data via the appropriate credit card network to the issuing bank for settlement.

C.) Applicant alleges that the prior art made of record fails to teach each host computer being configured to process at least one of the predetermined second format type. The examiner disagrees with applicant's representative since Itakura teaches each host computer being configured to process at least one of the predetermined second format type (para 25-26, 0031-0034, 0068, 0103-0104, 0111, and 0118-0123; figs. 1, 13-14, 18, and 21). Itakura discloses the communication interface processes inputs and outputs to and from

the public line. Data is input by the user through the input device. The database interface can be connected to various databases composed of, for example, hard disk. The floppy disk drive reads the data or program from the floppy disk and transmits it to CPU. The calendar IC sends the date and time to CPU. The display displays communication state to the operator. The *host computer* executes the delivery process for sending the goods to the address stored in the RAM and transmits an order completion notice to the browser to indicate the completion of the order. The browser connects itself to the host computer, which is represented by the connection address, to notify the host computer of the order by transmitting the goods name, the payment acknowledge ID, to the mailing address and name to the host computer. The host computer executes the delivery process and notifies the browser of the completion of the delivery process, which is then transmitted from the browser to the message viewer. The message viewer displays the completion of the order on the message viewer window.

With regards to the claims rejected as taught by Keresman and Itakura, the examiner would like to point out that the references teach the claimed limitations and thus provides adequate support for the claimed limitations. Therefore, the examiner maintains that Keresman and Itakura taught the claimed limitations.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3693

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Keresman, III et al. (US 7,051,002) in view of Itakura et al. (US 2005/0010488).

Re claims **1** and **19**, Keresman et al disclose a system and method located at a merchant site for processing an electronic payment transaction (figs. 2-3, col. 3, line 11-15, line 30-34), comprising:

a processor (200, col. 7, line 22-65) located at a merchant site, the processor configured to:

receiving a request to process an electronic payment transaction from a payment terminal located at the merchant site, the request having a format type (col. 5, line 66 – col. 6, line 14);

determine the format type of the request (col. 6, line 67 – col. 7, line 5, col. 10, line 47-63);

identify a host computer configured to process the determined format type; and an interface located at the merchant site, the interface being coupled to the processor and configured to (50, col. 5, line 25-33 and line 58-65, i.e. the payment request is the checkout transaction initiated by the consumer/cardholder at his/her computer terminal 50 upon completion of a purchase transaction. The payment information will be processed by the request layer 110, see col. 9, line

65 – col. 10, line 6) the request including a format type (col. 6, line 4-14, i.e. a plurality of different payment types):

transmit the request to the identified host computer (col. 5, line 41-45, col. 10, line 47-63, Keresman et al disclose that because of the different types of payment, the formatted message will routed to the issuing entity i.e. "host" for authentication).

However, Keresman does not explicitly teach from among a plurality of predetermined second format types and from among a plurality of host computers, each host computer being configured to process at least one of the predetermined second format type. On the other hand, Itakura discloses from among a plurality of predetermined second format types and from among a plurality of host computers, each host computer being configured to process at least one of the predetermined second format type (para 25-26, 0031-0034, 0068, 0103-0104, 0111, and 0118-0123; figs. 1, 13-14, 18, and 21). Itakura the host computer of the store is connected to the message distribution system through the private line. He discloses the information provider is administered by a so-called World Wide Web provider, and is connected to a plurality of host computers through the Internet (World Wide Web). The information provider is also connected to the payment system through a private line. Thus, it would have been obvious to one of ordinary skill in the art to enable a plurality of predetermined second format and a plurality of host computers to process at least one of the predetermined second format type in order to transmit the credit card information in secure manner by a private network.

Re claims **2** and **20**, Keresman et al also disclose the processor (200, see also discussion w/r to claim 1) is further configured for receiving a notification from the identified host indicating whether the request is approved (col. 10, line 63-67, col. 11, line 1-20). Keresman et al disclose that the processor "MAPS" 200 receives enrollment status confirmation from the issuing entity i.e. "host" regarding a consumer/cardholder). and transmits this confirmation message to the merchant's server 100, i.e. the interface. Hence, it teaches that a non-confirmed message about enrollment of a consumer/cardholder sent by the issuing entity to the merchant's server 100 constitutes an error message as claimed.

Re claims **3** and **21**, Keresman et al also disclose the interface (100, see discussion w/r to claim 1 above) is further configured for receiving a notification from the identified host indicating whether the request contains an error message (col. 10, line 63-67, col. 11, line 1-20). Keresman et al also disclose that the issuing entity i.e. "host" transmits a confirmation message about the enrollment status of a consumer/cardholder to the merchant's server 100, i.e. the interface via the processor "MAPS" 200. Hence, it teaches that a non-confirmed message about enrollment of a consumer/cardholder sent by the issuing entity to the merchant's server 100 constitutes an error message as claimed.

Re claims **4-5** and **22-23**, Keresman et al disclose an authentication process wherein the processor is further configured for sending the notification to the payment terminal (See discussion w/r to claims 3 and 21, col. 10, line 63-67, col. 11, line 1-29). Keresman et al disclose that the processor "MAPS" 200 receives enrollment status



confirmation from the issuing entity i.e. "host" regarding a consumer/cardholder and transmits this confirmation message to the merchant's server 100, i.e. the interface. This enrollment confirmation status message is ultimately being relay to the consumer/cardholder via the merchant's server 100 web page).

Re claims **6** and **24**, Keresman et al disclose formatting data i.e. payment transaction requests into specific message format such as XML, and transmitting these formatted data over HTTPS protocol (col. 6, line 54-56, col. 7, line 1-7). Data packets having header information as claimed are from the XML formatted data transmitted over HTTPS protocol.

Re claims **7** and **25**, Keresman et al disclose the processor "MAPS" 200 adapted to encode i.e. process/format message data into XML, and to transmit these data over HTTPS protocol (col. 7, line 47-50, col. 8, line 12-14). Encoding header information is in the processing/formatting of message data into XML format to be transmitted over HTTPS protocol.

Re claims **8** and **26**, which further recite the header information is encoded using an Extensible Markup Language, see discussion w/r to claims 6-7 and 24-25 above.

Re claims **9** and **27**, in Keresman et al, the request for processing the electronic payment transaction relates to authorizing the transaction (see discussion w/r to claim 1. The authorization of payment is carried out through the authentication process between the merchant's server i.e. interface and the issuing entity i.e. "host" via the processor 200 "MAPS". See col. 10, line 53-67 for example).

Re claims **10** and **28**, in Keresman et al, the request for processing the electronic payment transaction (see discussion w/r to claims 1-9 and 19-27) is the process of settling the transaction (see also col. 5, line 66 – col. 6, line 14).

Claims **11-18**, **29-36**, and **42-46** have been analyzed and rejected w/r to claims 1-10 and 19-28 above.

Re claim **37**, Keresman et al disclose computer and server to facilitate the electronic payment processing system and method. Hence, a serial connection is an example of a USB (universal serial bus) connection.

Re claims **38-40**, Keresman et al disclose the same internet protocol as claimed (col. 5, line 58-65). TCP/IP is in the internet protocol.

Re claim **41**, Keresman et al disclose processing electronic payment requests over the internet (see discussion w/r to claims 1 and 38-40). Hence, accessing the internet necessitates a modem.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3693

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday to Friday from 6am-2pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Thu Thao Havan/  
Primary Examiner  
Art Unit 3693  
6/10/08

**Application Number****Application/Control No.**

10/799,254

**Applicant(s)/Patent under  
Reexamination**

SANCHEZ ET AL.

**Examiner**

THU-THAO HAVAN

**Art Unit**

3693